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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sextro Art Unit: 2612

Serial No.: 09/829,468 Examiner: Lu, Shirley

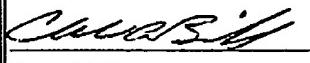
Filed: 9 April 2001 Docket No.: TI-30905

For: FEATURES FOR INTERACTIVE TELEVISION

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

19 January 2007

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	<u>19JAN2007</u>
Charles A. Brill	Date

Dear Sir:

The following Appeal Brief is respectfully submitted in connection with the above-identified application in response to the Final Rejection mailed 19 April 2006, and the Advisory Action mailed 17 October 2006. Please charge all required fees, including any extension of time fees, to the deposit account of Texas Instruments Incorporated, Deposit Account No. 20-0668.

REAL PARTY IN INTEREST

The real party in interest is Texas Instruments Incorporated, to whom this application is assigned.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Applicant's legal representative.

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STATUS OF THE CLAIMS

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This application was originally filed on 9 April 2001 with twenty-three claims, two of which were written in independent form. Claims 1, 2, 11, and 18 were amended, and Claims 20-23 canceled on 30 January 2006. Claims 18 and 19 were canceled on 19 September 2006. No claims have been allowed. Claims 1-17 are the subject of this appeal.

STATUS OF THE AMENDMENTS

An amendment after the final rejection was submitted 19 September 2006. Although the amendment only canceled Claims 18 and 19, the Examiner refused entry of the amendment. Claims 1-17 have been appealed.

SUMMARY OF CLAIMED SUBJECT MATTER

Line 8 of page 5 of the specification, through line 10 of page 7, with reference to Figures 1 and 2, and Table 1, provides a concise explanation of the invention defined in both independent claim 1 and independent claim 11. The process described in claims 1 and 11 receives a terrestrial broadcast (100) comprising a video stream with embedded commands. The embedded commands, which are described on lines 15-22 of page 10, are synchronized with additional content provided via the internet. Internet content is received via satellite transmission and internet communications are transmitted via landline. The internet content is superimposed on the video stream received by the terrestrial broadcast. Claim 11 describes the embedded commands as prompting access to Internet sites offering pushed products selected using analysis of the viewer's habits as taught by lines 13-16 of page 7, and lines 10-16 of page 9,

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GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,324,694 to Butler *et al.* in view of U.S. Patent No. 5,938,737 to Smallcomb.
2. Whether Claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application Publication No. 2004/0117831 to Ellis *et al.* in view of U.S. Patent No. 5,938,737 to Smallcomb.
3. Whether Claim 11 is unpatentable under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2004/0117831 to Ellis *et al.*

ARGUMENT**Ground of Rejection 1:**

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,324,694 to Butler *et al.* (“Butler”) in view of U.S. Patent No. 5,938,737 to Smallcomb (“Smallcomb”). The applicant respectfully disagrees.

The applicant respectfully notes at the outset that the Examiner’s reference to U.S. Patent No. 6,324,694 as being issued to Butler *et al.* appears to be in error. U.S Patent No. 6,324,694, entitled “Method and Apparatus for Providing Subsidiary Data Synchronous to Primary Content Data” was issued on 27 November 2001 to Watts *et al.* (“Watts”). U.S. Patent Application Publication No. 2002/0007493 to Butler *et al.* was cited by the Examiner in the “Notice of References Cited” and appears to be the document intended to be cited by the Examiner. The Examiner apparently has not pointed to any teaching in Watts and therefore has failed to establish a *prima facie* case of obviousness based on Watts.

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"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject

matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Graham v. Deere*, 383 U.S. 1, 17-18 (1966).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). ‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” MPEP § 2143.03.

“To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Claim 1 recites “receiving a terrestrial broadcast signal comprising a video stream,” “receiving said Internet-based content via satellite transmission,” and “transmitting information via landline transmission,” where “said embedded commands synchronized and correlated with additional Internet-based content.”

The Examiner stated, “Butler fails to specifically teach, said embedded commands synchronized and correlated with additional Internet-based content.” The Examiner further states, “Smallcomb discloses said embedded commands synchronized and correlated with additional Internet-based content . . . (satellite downstream telephone line upstream for internet data; col. 3, lines 41-67).”

The applicant respectfully submits the Examiner has not pointed to any teaching in Smallcomb that supports the Examiner's assertion. Specifically, the Examiner has not pointed to any teaching in Smallcomb that "said embedded commands synchronized and correlated with additional Internet-based content" are "embedded in the video stream" as required by Claim 1, nor has the Examiner shown the references expressly or impliedly suggest the claimed combination or presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Examiner has not met the burden of presenting a *prima facie* case of obviousness. Therefore, the rejection of Claim 1 under 35 U.S.C. § 103(a) as unpatentable over Butler in view of Smallcomb is defective and should be withdrawn.

Ground of Rejection 2:

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0117831 to Ellis *et al.* ("Ellis") in view of U.S. Patent No. 5,938,737 to Smallcomb.

The Examiner stated, "Ellis fails to specifically teach, said embedded commands synchronized and correlated with additional Internet-based content." The Examiner further states, "Smallcomb discloses said embedded commands synchronized and correlated with additional Internet-based content . . . (satellite downstream telephone line upstream for internet data; col. 3, lines 41-67)."

The applicant respectfully submits the Examiner has not pointed to any teaching in Smallcomb that supports the Examiner's assertion. Specifically, the Examiner has not

pointed to any teaching in Smallcomb that "said embedded commands synchronized and correlated with additional Internet-based content" are "embedded in the video stream" as required by Claim 1, nor has the Examiner shown the references expressly or impliedly suggest the claimed combination or presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Examiner has not met the burden of presenting a *prima facie* case of obviousness. Therefore, the rejection of Claim 1 under 35 U.S.C. § 103(a) as unpatentable over Ellis in view of Smallcomb is defective and should be withdrawn.

Ground of Rejection 3:

Claim 11 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0117831 to Ellis *et al.* The applicant respectfully disagrees and submits the Examiner has failed to make a *prima facie* case of anticipation.

Claim 11 recites, "providing a broadcast signal comprising a video stream."

The Examiner stated, "As to claim 11 Ellis *et al.* discloses: providing a broadcast signal comprising a video stream ('FIG. 1 shows a video broadcasting system in accordance with one embodiment of the invention, generally designated by reference numeral 10. Broadcasting system 10 includes a broadcast source 12 and a plurality of receivers 14. The broadcast source in this embodiment of the invention is a digital satellite system that broadcasts video content on multiple RF frequencies or channels.' [0013])."

The applicant respectfully submits this passage, which appears to be from Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

Claim 11 recites, "embedding commands in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content."

The Examiner stated, "As to claim 11 Ellis et al. discloses: . . . embedding commands in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content ('Broadcast source 12 includes means for transmitting or otherwise conveying a primary video stream and ancillary digital data content to receivers 14. In the case of digital satellite transmission, ancillary data can be easily transmitted in digital form along with video and audio streams. Protocols such as MPEG-2 already provide for incorporating ancillary digital data in packets that are downloaded with digital audio/video content using satellite transmission facilities. Another example is in the analog realm, in which Philips sells a device called the Ghost Echo Cancellation Reference Signal. By injecting a known digital stream on a single analog television VBI line, advanced televisions or PCs can more easily detect when a multipath (ghost) signal is received and take measures to clean up the image' [0015]; 'A step 222 comprises formatting supplemental data files in a graphical markup language, preferably HTML. Each supplemental HTML data file has instructions for rendering a hyperlink page or overlay on the video stream at an indicated time. Overlays can also contain hyperlinks to other overlays and to other non-overlay documents and objects' [0051]).'"

The applicant respectfully submits this passage, which appears to be a misquote of Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

Claim 11 recites, "displaying said additional Internet-based content superimposed on said video stream from said broadcast signal."

The Examiner stated, "As to claim 11 Ellis et al. discloses: . . . 'displaying said additional Internet-based content superimposed on said video stream from said traditional broadcast signal ('FIG. 3 shows how this is accomplished. An overlay window 200 is opened for displaying a hyperlink overlay. Video subsystem 66 is configured to display the video stream in a viewport 201 that coincides in size and position with the overlay window 200. Thus, non-transparent areas of the hyperlink overlay appear 'through' the video stream, and appear to overlay the video stream' [0044]; 'A step 222 comprises formatting supplemental data files in a graphical markup language, preferably HTML. Each supplemental HTML data file has instructions for rendering a hyperlink page or overlay on the video stream at an indicated time. Overlays can also contain hyperlinks to other overlays and to other non-overlay documents and objects' [0051]).'"

The applicant respectfully submits this passage, which appears to be a misquote of Butler, is not found in Ellis. Therefore the Examiner has not cited any teaching in Ellis that would anticipate this limitation of Claim 1.

Claim 11 recites, "said embedding comprising embedding commands in said video stream to prompt access to Internet sites offering pushed products selected using analysis of said viewer's habits."

The Examiner stated Ellis discloses, “The user may also view a listing of pay-per-view sports by selecting option 357, or a listings of sports programs on now by selection option 358. The user may purchase sports-related merchandise through an interactive shopping application by selecting option 359. Sports hub screen 350 may also display options for accessing sports web sites, sports discussion groups, sports chat groups, and other program guide features (e.g., any features shown and used with other hubs) with sports-related content.’ [0166]; ‘Screen 400 may also provide other options such as the option to buy tickets for local sports events by selecting option 403. When the user selects option 403, the program guide may provide a schedule of sporting events. The user may select a sporting event to purchase a ticket for that event. Sporting schedules may be obtained from a real-time data source, server, or other database.’ [0185]; [0167]; ‘Selecting Specials option 132G from Movies screen 130 (FIG. 5) may display a screen such as screen 220 shown in FIG. 14. This screen presents list 221 of special offers related to movies that may be available from the system provider. These offers may include a special deal on a VOD movie, buy one get one free offers, movie clubs allowing the user to get discounts on purchases of multiple movies, upgrades of single or multiple movie channels, etc. Selecting a specific offer may display a screen similar to the Program Information screen with details on the offer, such as price and description, and the option to purchase the offer. When the user purchases one of the special offers, this information along with the user's account information may be transmitted to the television distribution for processing so that the user can access the purchased channels, programs, etc., and the user's account may be debited. Further features of an illustrative interactive television program guide system with pay program

package promotion are described in Knudson et al. U.S. patent application Ser. No. 08/944,153, filed Oct. 6, 1997, which is hereby incorporated by reference herein in its entirety. While viewing the Program Information screen for any program that is part of a special offer, the guide may present the option to view and/or purchase any of those offers.' [140]; 'guide may provide web sites or merchandise in a shopping application that match the user's preferences' [0203]."

The applicant respectfully submits that the extensive quotes from Ellis relied upon by the Examiner do not show, teach, or suggest the above limitation of Claim 11. The passages cited by the Examiner suggest a display of "special offers related to movies that may be available from the system provider," "a listing of pay-per-view sports," "a listings of sports programs on now," "the option to buy tickets for local sports events," and "a schedule of sporting events." None of these appear to be related to be "selected using analysis of said viewer's habits" as required by Claim 11.

One passage cited by the Examiner states, "the guide may provide web sites or merchandise in a shopping application that match the user's preferences." Providing merchandise that matches user preferences, however, does not show, teach, or suggest "embedding commands in said video stream to prompt access to Internet sites offering pushed products selected using analysis of said viewer's habits" as required by Claim 11. A user's preferences are not the same as a viewer's habits.

As the Examiner failed to present a *prima facie* case of anticipation of Claim 11 by Ellis, the rejection of Claim 11 is unsupported by the prior art and should be withdrawn.

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CONCLUSION

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For the foregoing reasons, Appellants respectfully submit that the Examiner's final rejection of Claims 1 and 11 is improper, and it is respectfully requested that the Board of Patent Appeals and Interferences so find and reverse the Examiner's rejection.

Please charge any fees necessary in connection with the filing of this paper, including any necessary extension of time fees, to Deposit Account No. 20-0668 of Texas Instruments Incorporated.

Respectfully submitted,



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CLAIMS APPENDIX

1. (Previously presented) A method for interactive television, the method comprising:
 - receiving a terrestrial broadcast signal comprising a video stream;
 - interpreting commands embedded in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content;
 - receiving said Internet-based content via satellite transmission and sending transmitting information via landline transmission; and
 - displaying said additional Internet-based content superimposed on said video stream from said terrestrial broadcast signal.
2. (Previously presented) The method of Claim 1, said embedding comprising embedding HTML or Java commands.
3. (Original) The method of Claim 1, comprising:
 - providing a digital interactive set-top box coupled to a standard television, said interactive set-top box accessing said additional Internet-based content and superimposing said content on said video stream.
4. (Original) The method of Claim 1, said embedding comprising embedding delimiters to define sequential video clips for storage and future display,
5. (Original) The method of Claim 1, said embedding comprising embedding delimiters to define sequential video clips for storage and future display, each of said sequential video clips comprising a segment of a sporting event.
6. (Original) The method of Claim 5, comprising:
 - storing one or more of said video clips of said selected plays;
 - summarizing said stored video clips with a graphic summary including coded indicators denoting types of plays;
 - replaying one of said video clips upon viewer selection of a corresponding said coded indicator.
7. (Original) The method of Claim 6, comprising selecting a fixed graphic format for viewing on a standard non-interactive television.
8. (Original) The method of Claim 1, said embedding comprising embedding

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- commands in said video stream to facilitate polling of viewers, allowing said viewers to vote on an aspect of said simultaneously displayed broadcast data.
9. (Original) The method of Claim 1, said embedding comprising embedding commands in said video stream to prompt access to Internet sites offering pushed products.
10. (Original) The method of Claim 1, said embedding comprising embedding commands in said video stream to prompt access to Internet sites offering pushed products selected from the group consisting of: tickets to future sporting events, travel packages, and sports apparel.
11. (Previously presented) A method for interactive television, the method comprising:
- providing a broadcast signal comprising a video stream;
- embedding commands in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content, said embedding comprising embedding commands in said video stream to prompt access to Internet sites offering pushed products selected using analysis of said viewer's habits; and
- displaying said additional Internet-based content superimposed on said video stream from said broadcast signal.
12. (Original) The method of Claim 1, said embedding comprising embedding commands enabling a viewer to interactively complete a transaction to purchase various products by selecting an Internet generated icon on the display screen.
13. (Original) The method of Claim 1, said embedding comprising embedding commands enabling a viewer to interactively complete a transaction to purchase various products and receive confirmation of said transaction in real-time on a display screen.
14. (Original) The method of Claim 1, said embedding comprising embedding commands utilizing streaming data from said Internet or television broadcast to further enhance the viewing experience by continuously superimposing interactive data in various locations on said broadcast video.

15. (Original) The method of Claim 1, said embedding comprising embedding commands utilizing streaming data comprising a selected personalized portfolio of stocks, the ticker for said selected portfolio being taken from market data embedded in said video stream and presented and updated in a banner or window on said display screen.
16. (Original) The method of Claim 1, comprising editing interactive data selected from a group consisting of sports teams and portfolio stocks from a screen menu in real-time.
17. (Original) The method of Claim 1, comprising providing taskbars displaying various accounts in the home.
18. (Previously presented) An interactive television system, comprising:
 - a broadcast video receiver for receiving video data from a video provider service via terrestrial broadcast transmission;
 - an internet browser providing bi-directional access to internet content, said internet browser receiving said internet content via satellite transmission, and said internet browser sending said internet content via landline transmission;
 - a graphics processor capable of receiving said broadcast video content and said internet content and providing combined video data comprised of both broadcast video content and internet content;
 - a display in communication with said graphics processor for displaying said combined video data; and
 - a viewer interface interpreting viewer input and sending corresponding data content through said internet browser to a third party.
19. (Original) The system of Claim 18, said internet browser, said graphics processor, and said viewer interface comprising an interactive set-top box.
- 20-23. (Canceled)

EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.

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